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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,931	01/08/2002	Marc Wasberg	2302.2060	8802
5514	7590	06/09/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			BECKER, DREW E	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/937,931

Applicant(s)

WASBERG ET AL.

Examiner

Drew E. Becker

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-14, 17, 18, 20, 21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-14, 17-18, 20-21, 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-7, 9-14, 17-18, 20-21, and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application does not appear to disclose "bursting".

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1761

4. Claims 1-2, 4-7, 9, 11, 13, 17, 20-21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jud [Pat. No. 4,658,963].

Jud teaches an item comprising a product (Figure 4, #5), a flexible film enclosing the product and an amount of gas (Figure 4, #1), a precut line perpendicular to the longest side (Figure 2, #3), opening the package by bending it to rupture only the precut line (Figures 4-5), the bending inherently causing increased pressure and tensioning, several products of equal size within the package (Figure 7), the precut line located adjacent two of the products (Figure 7, #28), the film having two superposed layers with the precut in a bottom layer (Figure 1, #2), the use of polypropylene (column 3, line 54), the product being chocolate (column 3, line 2), a method of making the item wherein the film is shaped first (column 2, lines 45-61; Figure 1, #2), and a device for making the item comprising a packaging machine (column 2, line 56). Phrases such as "a consumer can grasp the item in both hands near opposite ends" are merely preferred methods of using the claimed product.

5. Claims 1-4, 7, 11-14, 17, 20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Haiss [Pat. No. 4,290,526].

Haiss teaches an item comprising a product (Figure 2, #9), a flexible film enclosing the product and an amount of gas (Figure 1a, #1), a precut line perpendicular to the longest side (Figure 1a, #3), opening the package by rupturing only the precut line (Figures 1-2), the bending inherently causing increased pressure and tensioning, a joining line (Figure 1, #4), the film having two superposed layers (column 2, lines 1-5), the use of polypropylene and polyethylene (column 2, lines 4-5), the product being chocolate or ice

Art Unit: 1761

cream (column 1, line 10), a method of making the item wherein the film is shaped first (column 2, lines 1-38), and inherently including means for making the item. Phrases such as "bending the item" are merely preferred methods of using the claimed product, an apparatus. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647. MPEP 2114. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

6. Claims 1-4, 7, 9-13, 17-18, 20, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Marbler [Pat. No. 5,934,809].

Marbler teaches an item comprising a product (Figure 5, #26), a flexible film enclosing the product and an amount of gas (Figure 4, #16), a precut line perpendicular to the longest side (Figure 4, #18), opening the package by bending it to rupture only the precut line (column 5, line 48), the bending inherently causing increased pressure and tensioning, a joining line (Figure 3, #19), the film having two superposed layers with the precut extending through an outer layer (Figure 6, #21-22), the use of polypropylene and polyethylene (column 2, lines 15-25), the precut line being present in one of the

Art Unit: 1761

outer layers without extending into an inner layer (Figure 6, #18 & 21-22), the product being chocolate (column 5, line 66), a method of making the item wherein the film is shaped first (column 5, lines 25-34), and a means for making the item (Figure 1).

7. Claims 1-2 and 17 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/45127.

Martel et al [Pat. No. 6,315,480] shall be treated as a translation of WO 98/45127.

Martel et al teach an item and method comprising a product (column 9, line 30), a flexible film enclosure containing the product and an amount of gas (Figure 17, #41-43), bending the item until it bursts (Figure 17), a precut line (Figure 16, #43), and inherently including means for producing the item.

### ***Response to Arguments***

8. Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive.

Applicants argue that none of the references teach grasping the item "in such a way as to compress the item so as to increase the pressure of the gas to such a point that bending the item causes the enclosure to open by bursting... instantaneously along the most part of the precut line". However, all the references included a product and gas within the package and the internal pressure would have inherently increased when the packages were grasped and bent. Furthermore, the claim specifically states that "bending the item causes the enclosure to open by bursting", rather than solely gas pressure.

Applicants argues that none of the references contained a gas. However, for this to be true they would have needed to packaged under a vacuum. None of the references disclose, or even suggest, a vacuum.

Applicants argue that the references are "tightly packed" and could not contain more than a "very small" amount of gas. However, none of the present claims recite the amount of gas used, or any other information regarding the volume of gas or product. Furthermore, the sample submitted to the examiner in the interview of April 6, 2005 also appeared to be "tightly packed" and contained only a small amount of gas. This would lead one to suspect that the bending of the item creates the majority of pressure upon the packaging.

Applicants argue that the references pulled the items apart while bending them. However, it should be noted that applicants' own figures 3-5 explicitly teach pulling the item apart as it was bent. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., shaping steps and other features described in the specification) are not recited in

Art Unit: 1761

the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants argue that the references do not include a precut line transverse to a longer dimension in a central section. However, Haiss shows a precut line transverse to a longer dimension in a central section between the two ends (Figure 1, #3), Jud shows a precut line transverse to a longer dimension in a central section between the two ends (Figure 2, #3), and Marbler shows a precut line transverse to a longer dimension in a central section between the two ends (Figure 4, #18).

Applicants argue that WO 98/45127 does not include a gas. However, the Martel et al specifically describes the package containing "one or more doses of a fluid product, such as a liquid, creamy, gelatinous or gaseous product" (column 1, line 6). Applicants also argue that the hermetic seal of Martel et al "suggests a vacuum". However, the term "hermetic seal" is a commonly used term in the packaging art which simply means that the package has been sealed air-tight and is impervious to outside forces or elements. See Merriam Webster's Collegiate Dictionary.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within




TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner  
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